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PITNEY BOWES INC.			VETTER, DANIEL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/612,283	BURTON ET AL.	
	Examiner	Art Unit	
	DANIEL P. VETTER	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 November 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,4-11 and 13-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,2,4-11 and 13-18 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 1-18 were previously pending in this application. Claims 1, 2, 4-11, 13-18 were amended, and claims 3 and 12 were canceled in the reply filed November 14, 2008. Claims 1, 2, 4-11, 13-18 are currently pending in this application.

Response to Arguments

2. Applicant's amendments and arguments do not overcome the rejection of claims 1 and 2 under § 101. The assembling of packages is only recited as an insignificant post-solution activity. Accordingly, the rejections are maintained (see below).
3. Applicant's amendments to claims 17 and 18 overcome the rejection made under § 112, second paragraph, and it is withdrawn.
4. Applicant's arguments with respect to the rejections made under § 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Claims 1 and 2 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter

that is being transformed (e.g., by identifying the product or material that is changed to a different state). The claims do not recite any computerized or mechanical apparatus used to perform the process. And while the claimed invention determines a number of packages, no details of the packaging or assembling are ever recited. Claim 1 as amended broadly requires "assembling the determined number of packages," however this is merely an insignificant post-solution activity. The recited machine or transformation must principally relate to how the solution is achieved to impose meaningful limits on the claim scope. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc) (clarifying the "machine-or-transformation" test). As such, the claims concretely identify neither the apparatus performing the recited steps nor any significant transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wong, et al., U.S. Pat. No. 4,674,052 (Reference A of the attached PTO-892).

10. As per claim 1, Wong teaches a method for automatically selecting and packaging items for mailing, comprising the steps of: storing item characteristics for a plurality of items, the item characteristics including at least one of a weight and a thickness of each of the plurality of items (col. 11, lines 10-13, 33-42); receiving an order specifying a plurality of items for a shipment (col. 2, lines 22-30); storing a list comprising identifiers corresponding to the plurality of items specified in the order (col. 6, lines 27-36); determining, based on the identifiers and the stored item characteristics corresponding to the identifiers at least one of a total weight and total thickness for the plurality of items specified in the order (col. 11, lines 10-14); comparing the at least one

of the total weight and total thickness to at least one of a maximum weight and maximum thickness allowable for a postal class that will be used for mailing the shipment (col. 11, lines 15-18); determining a number of packages required for the shipment and which items of the order will be contained in each package such that the at least one of the total weight and total thickness of each package will be less than the at least one of the maximum weight and maximum thickness allowable for the postal class that will be used for mailing the shipment (col. 11, lines 15-28); and assembling the determined number of packages (col. 2, lines 22-53).

11. As per claim 10, Wong teaches a system for selecting and packaging items for mailing, comprising: a processor (col. 4, line 55); memory connected to the processor, the memory storing data and instructions for controlling the operation of the processor (col. 4, lines 54-56); the processor operative to perform the steps of: storing item characteristics for a plurality of items, the item characteristics including at least one of a weight and a thickness of each of the plurality of items (col. 11, lines 10-13, 33-42); receiving an order specifying a plurality of items for a shipment (col. 2, lines 22-30); storing a list comprising identifiers corresponding to the plurality of items specified in the order (col. 6, lines 27-36); determining, based on the identifiers and the stored item characteristics corresponding to the identifiers at least one of a total weight and total thickness for the plurality of items specified in the order (col. 11, lines 10-14); comparing the at least one of the total weight and total thickness to at least one of a maximum weight and maximum thickness allowable for a postal class that will be used for mailing the shipment (col. 11, lines 15-18); and determining a number of packages required for the shipment and which items of the order will be contained in each package such that the at least one of the total weight and total thickness of each package will be less than the at least one of the maximum weight and maximum thickness allowable for the postal class that will be used for mailing the shipment (col. 11, lines 15-28).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong, et al. in view of a finding of Official Notice considered admitted prior art.

14. As per claims 2 and 11, Wong teaches claims 1 and 10 as above. Wong does not teach the order is received by mail on a pre-printed form. Official Notice was previously taken and not disputed that it is old and well known in the art to employ pre-printed forms for mail order. There has been no attempt to traverse this finding despite the opportunity to do so and therefore it is considered admitted prior art. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into Wong to receive the orders on forms that are pre-printed by the company in order to make order processing standardized and therefore simpler.

15. Claims 4, 5, 9, 13, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong, et al. in view of Keong, U.S. Pat. Pub. No. 2005/0102203 (Reference A of the PTO-892 part of paper no. 20071210).

16. As per claim 4, Wong teaches claim 1 as above. Wong generally teaches printing respective mailers (col. 4, lines 33-37). However, Wong does not explicitly teach each mailer corresponding to a package for the shipment, each mailer defining the items that will be contained in the corresponding package; placing each mailer on an assembly line; and placing each item that will be contained in each package on the corresponding mailer as the mailer traverses the assembly line; which are all taught by Keong (¶¶ 0118, 126, 127, Fig. 1). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate these teachings into Wong's assembly system because it is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have

recognized that the combination could be implemented through routine engineering producing predictable results. Examiner is interpreting a network of sorting stations and order assembly bays as an assembly line. Examiner notes that although Keong teaches using two separate labels corresponding to the package, it would have been obvious at the time of invention to combine these labels onto the single mailer according to known methods to achieve a predictable result. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (holding that combining prior art elements into one piece would be an obvious engineering choice).

17. As per claim 5, Wong in view of Keong teaches claim 4 as above. Wong further teaches each mailer comprises a printed paper mailer (col. 4, lines 33-37), wherein each paper mailer includes on a second side a delivery address for the corresponding package (col. 4, lines 33-37). Keong further teaches each paper mailer includes, on a first side, an RF tag indicative of the items to be packaged with the mailer as well as printed information (¶¶ 0131-32). Examiner acknowledges that Keong teaches using an RF tag rather than the claimed bar code, however it would have been obvious at the time of invention to use a bar code instead of an RF tag because Keong explicitly teaches the use of bar codes for this purpose in prior art systems, even though they are not employed in the preferred embodiment (¶ 0004). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the bar codes of Keong because this is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. Moreover, it also would have been obvious to combine Wong's and Keong's mailers together into a single mailer according to known methods to achieve the predictable result of an advantageous one-piece composition. *Larson*, 340 F.2d at 968.

18. As per claim 9, Wong in view of Keong teaches claim 4 as above. Keong further teaches the order is received at a location geographically remote from the assembly line (¶ 0094); which would have been obvious to include because it is merely a combination

of elements already known in the art of shipping orders. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

19. As per claim 13, Wong teaches claim 10 as above. Wong further teaches an assembly line for assembling each of the packages (col. 3, lines 31-34). Wong generally teaches printing respective mailers (col. 4, lines 33-37). However, Wong does not explicitly teach a printed mailer for each package in the shipment, the printed mailer for each package being placed on the assembly line, wherein each item in each package is placed on the associated mailer as the mailer traverses the assembly line; which are all taught by Keong (¶¶ 0118, 126, 127, Fig. 1). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate these teachings into Wong's assembly system because it is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. Examiner is interpreting a network of sorting stations and order assembly bays as an assembly line. Examiner notes that although Keong teaches using two separate labels corresponding to the package, it would have been obvious at the time of invention to combine these labels onto the single mailer according to known methods to achieve a predictable result. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (holding that combining prior art elements into one piece would be an obvious engineering choice).

20. As per claim 14, Wong in view of Keong teaches claim 13 as above. Wong further teaches each mailer comprises a printed paper mailer (col. 4, lines 33-37); wherein each paper mailer includes on a second side a delivery address for the corresponding package (col. 4, lines 33-37). Keong further teaches each paper mailer includes, on a first side, an RF tag indicative of the items to be packaged with the mailer as well as printed information (¶¶ 0131-32). Examiner acknowledges that Keong teaches using an RF tag rather than the claimed bar code, however it would have been

obvious at the time of invention to use a bar code instead of an RF tag because Keong explicitly teaches the use of bar codes for this purpose in prior art systems, even though they are not employed in the preferred embodiment (¶ 0004). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the bar codes of Keong because this is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. Moreover, it also would have been obvious to combine Wong's and Keong's mailers together into a single mailer according to known methods to achieve the predictable result of an advantageous one-piece composition. *Larson*, 340 F.2d at 968.

21. As per claim 18, Wong in view of Keong teaches claim 13 as above. Keong further teaches the processor is at a location geographically remote from the assembly line (¶¶ 0103, 120); which is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

22. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong, et al. in view of Keong as applied to claims 5 and 14 above, further in view of Farmer, U.S. Pat. No. 2,276,293 (Reference C of the PTO-892 part of paper no. 20070105).

23. As per claim 6, Wong in view of Keong teaches claim 5 as above. Keong further teaches scanning the RF tag on each mailer to determine the items of the order that will be contained in the package corresponding to the mailer (¶ 0132). It would have been obvious to include this element and replace the RF tag with a bar code for the reasons set forth in claim 5 above. Wong in view of Keong does not explicitly teach moving the items from a hopper onto the mailer to assemble the package corresponding to the

mailer; which is taught by Farmer (page 4, right column, line 71 - page 5, left column, line 2). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above hopper of Farmer because it is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

24. As per claim 15, Wong in view of Keong teaches claim 14 as above. Keong further teaches a scanner for reading the bar code on each mailer (¶ 0132). It would have been obvious to include this element and replace the RF tag with a bar code for the reasons set forth in claim 14 above. Wong in view of Keong does not teach a plurality of hoppers, each hopper containing a plurality of like items; and a mechanism responsive to computer control for moving an item from a hopper onto a mailer. Farmer teaches a plurality of hoppers (page 2, left column, line 8), each hopper containing a plurality of like items (page 2, left column, line 9); and a mechanism responsive to electrical control for moving an item from a hopper onto a mailer (page 4, right column, line 71 - page 5, left column, line 2). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Farmer in order to reduce cost, minimize time involved, and insure greater accuracy in assembling orders (as taught by Farmer, page 1, left column, lines 39-41). Moreover, this is merely a combination of old elements already known in order fulfillment systems. In the combination, no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. Farmer teaches that the mechanism is electronically actuated using a circuit (page 3, left column, lines 9-10) but does not explicitly teach that the mechanism is responsive to computer control. However, it would have been obvious at the time of invention and a matter of routine engineering by known methods to use any computer for control such as the one envisioned by Keong (¶ 0067) to achieve the predictable result of a more accurately controlled mechanism integrated with the system computer.

25. As per claims 7 and 16, Wong in view of Keong and Farmer teaches claims 6 and 15 as above. Wong further teaches printing on the mailer (col. 4, lines 33-37), but not that it is a message indicating that an order has been fulfilled in multiple packages. However, this printed matter is considered non-functional descriptive material and cannot lend patentability to an invention that would have otherwise been unpatentable over the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

26. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong, et al. in view of Keong and Farmer as applied to claims 7 and 16 above, further in view of a finding of Official Notice considered admitted prior art.

27. As per claims 8 and 17, Wong in view of Keong and Farmer teaches claims 7 and 15 as above. Wong in view of Keong and Farmer does not teach wrapping each of the packages in plastic wrap so that the delivery address and message are readable through the plastic wrap. Official Notice was previously taken and not disputed that it is old and well known in the art to shrink-wrap each of the packages in a plastic wrap so that an address and message are readable through the plastic wrap. There has been no attempt to traverse this finding despite the opportunity to do so and it is considered admitted prior art. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the method taught by Wong in view of Keong and Farmer because plastic wrap is commonly used in such a manner when shipping packages to provide stability and protection. Keong further teaches assembly stations (Fig. 1), but not that they are used to wrap the orders. However, as above, wrapping packages in plastic wrap is considered admitted prior art and it would have been obvious to incorporate this element because it is merely a combination of elements already known in the prior art. In the combination, no element would have served a function other than it already did

independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628